

Appl. No. 10/026,494  
Amdt. Dated January 14, 2004  
Reply to Office Action of December 5, 2003

REMARKS

Reconsideration of the application is requested.

Claims 1-8 remain in the application. Claims 1, 6, and 8 have been amended.

More specifically, the claims have been amended in response to the rejection under 35 U.S.C. § 112. We have followed the Examiner's suggestion and hope that the claims will now be deemed to satisfy the requirements of 35 U.S.C. § 112. The Examiner's effort in suggesting the changes is appreciated.

We now turn to the art rejection in which the claims have been rejected as being obvious over a combination of Phillips and Grierson under 35 U.S.C. § 103. We respectfully traverse.

The secondary reference Grierson, of course, has been discussed in detail in our prior submission, the Brief on Appeal of September 30, 2003. There we argued that Grierson's process is entirely different in character from the hot forming process to which the claimed invention pertains and Grierson indeed belongs to a different technological category. Besides discussing the differences between Grierson and the claimed invention in terms of 35 U.S.C. § 102, we also

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discussed in detail why a person of skill in the pertinent art would not modify Grierson towards the claimed invention.

The same arguments apply to the modification of Grierson towards the primary reference Phillips. In other words, Grierson and Phillips are as incompatible as Grierson and this invention are. Our Brief on Appeal and the remarks contained therein are herewith incorporated by reference.

Grierson describes shaping members formed of a W-Ni-Fe-Mo alloy that are used for high-temperature forming of metals. The term "high-temperature" as used by Grierson lies in an entirely different range from the temperatures to which the claimed invention as well as Phillips pertain. Grierson is entirely clear that his "shaping" exclusively means shaping by way of pouring, i.e., his shaping members are dies for receiving molten metal.

As explained by Grierson in col. 2, lines 13-14, his shaping members are resistant to cracking. This is further explained in col. 2, lines 4-8, where the term "cracking" is associated with the extremely high thermal expansion when the shaping members come into contact with the very high temperatures of the molten metal.

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The primary reference Phillips pertains to an entirely different art. Phillip deals with hot extruding and metal drawing, such as copper at high temperatures. These "high" temperatures are entirely different in range from those found in Grierson who, after all, requires the metal to be in the liquid phase. While Phillips deals with cracking problems (radial cracking, laminar cracking, etc.), these problems are based on an entirely different process in that they have to do with the mechanical stresses and shearing forces during mechanical processing.

It is therefore submitted that Phillips and Grierson cannot be combined because they belong to different categories in metal processing, because the respective problems to be solved by these teachings are entirely different, and because Phillips would not look to molten-metal dies to solve problems associated with mechanically introduced stress problems.

We are mindful of the Examiner's admonition that the "burden is on applicants" to show that materials taught in the prior art have a material effect on the overall composition and to thereby show the unobviousness of the combination. We respectfully submit, however, that the unobviousness of the modification does not lie in specifics of the materials but

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instead in the overall incompatibility. Our conclusion is a legal conclusion based on the underlying facts.

We conclude that the two references are factually incompatible and that we find no incentive in the art of record towards the combination and, furthermore, the combination can relatively easily be argued to be based on hindsight.

It is well settled that almost all inventions are but novel combinations of old features. The courts have held in this context that when "it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation **in the prior art** to make the selection made by the applicant".

Interconnect Planning Corp. v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985) (emphasis added). "Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination". In re Bond, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). "Under Section 103 teachings of references can be combined **only** if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital et al., 221 USPQ 929, 933, 732 F.2d 1572 (Fed. Cir. 1984) (emphasis original). "Although a

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reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be **'clear and particular.'**" Winner Int'l Royalty Corp. v. Wang, 53 USPQ2d 1580, 1587, 202 F.3d 1340 (Fed. Cir. 2000) (emphasis added; citations omitted); Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 56 USPQ2d 1456 (Fed. Cir. 2000). It is entirely clear from the record that there is no "clear and particular" teaching or suggestion in either of the two references towards the combination and, in fact, we have even shown by the above arguments that the references are completely incompatible and uncombinable.

Applicants respectfully submit that any teaching, suggestion, or incentive possibly derived from the prior art is only present with hindsight judgment in view of the instant application. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps . . . . The references **themselves** must provide some teaching whereby the applicant's combination would have been obvious." In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Here, no such teaching is present in the cited references.

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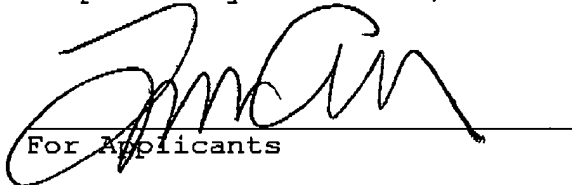
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In view of the foregoing, reconsideration and allowance of  
claims 1-8 are solicited.

Please charge any other fees that might be due with respect to  
Sections 1.16 and 1.17 to the Deposit Account of Lerner and  
Greenberg, P.A., No. 12-1099.

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Respectfully submitted,



For Applicants

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January 14, 2004

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